

Remarks

Claims 28-45 and 50-72 remain in the application. Claims 53, 55, 64 and 66 have been withdrawn as not readable on the elected species. Claim 52 has been amended to correct punctuation marks.

Although the Office Action Summary Page indicates claims 28-45 and 50-52 are rejected, Applicants believe that the Examiner has indicated on page 2 that claims 28-31 and 36-42 are allowed or allowable since the rejections of these claims "under 35 USC §103 have been withdrawn", and "all rejections under 35 USC §112, second paragraph are withdrawn in view of Applicants' amendment".

Election

The Examiner has suggested that the application contains claims directed to the following patentably distinct species of the claimed invention: different nitrogen-and/or sulfur-containing inhibitors (see, e.g., claims 52-56). Accordingly, the Examiner has required that Applicant elect a single disclosed species under 35 USC 121 for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicants hereby elect the species of "mercapto substituted nitrogen-containing heterocyclic compounds". The claims which are readable on this species include claims 28-45, 50-52, 54, 56-63, 65 and 67-72. Claims 53, 55, 64 and 66 are withdrawn from consideration as not readable on these elected species.

The Examiner's Response to Applicants Arguments

The Examiner has indicated on page 2 of the Communication of October 4, 2004 that Applicants' arguments filed on July 20, 2004 have been considered by the Examiner and in view of such arguments:

The rejections of claims 28-31 and 36-42 under 35 USC §103 have been withdrawn. All rejections under 35 USC §112, 2nd paragraph are withdrawn in view of Applicants' amendment.

Accordingly, Applicants submit that claims 28-31 and 36-42 should be indicated as allowed.

Regarding claims 32-35 and 43-45, the Examiner has indicated that Applicants' arguments regarding the concentration of Wernick are unconvincing because "differences in concentration of temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical". (MPEP 2144.05.II.A), and no such evidence has been presented.

The Examiner is requested to reconsider the rejection of claims 32-35 and 43-45 based upon Wernick. It is respectfully submitted that before the cited guidelines provided in MPEP 2144.05.II.A can be considered, it is well established that there must be some teaching in the prior art that would motivate one skilled in the art to modify the prior art as suggested by the Examiner. That is, the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. As noted in In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2nd 1397, 1399 (Fed. Cir. 1989).

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Quoting In re Gordon 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Applicants again submit that there is no suggestion or motivation in the art to significantly increase the amount of nickel present in the plating baths of Wernick beyond "a trace of nickel fluoroborate". A trace amount is illustrated in Wernick as containing 0.05 g/l of nickel fluoroborate which is equivalent to 0.0123 g/l of nickel. The teachings of Wernick would not motivate one skilled in the art to prepare a plating solution containing a minimum of 5 grams of nickel and/or cobalt ions as specified in claims 32-35, 43-45 and 60-70.

Regarding the Zelley reference, the Examiner has indicated that Applicants' arguments that Zelley teaches the addition of nickel or cobalt in alkaline rather than acidic solution is unconvincing "because Zelley does not teach that the improved adhesion would not be experienced by acidic zincating baths. Applicant agrees that Zelley does not teach that the improved adhesion would not be experienced by acidic zinc plating baths, but Applicants submit that this is evidence of non-obviousness based on lack of any teaching in the prior art of the desirability of utilizing Zelley's nickel or cobalt in an acidic solution, particularly, an acidic zincating bath of the type described by Suzuki. It is well established that a reference is relied upon as prior art for "what it teaches" to one skilled in the art. The Examiner cannot rely upon what a reference "does not teach".

Conclusion

In view of the amendments to the claims and the above remarks, it is respectfully submitted that all of the claims presently in the application are allowable.

Respectfully submitted,

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